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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,204	12/04/2001	Hiromichi Inagaki	Komatsu Case 260	8211

7590 05/28/2004

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/009,204

Applicant(s)

INAGAKI ET AL.

Examiner

Victor S Chang

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 10 May 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached NOTE.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 3-11.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

NOTE

1. The After Final Amendment is not entered. It is noted that the proposed amendments to claims 1 and 11 now recite "being brought into contact with and adhering to an article solely through deformation of the substrate" appears to be both "new matter" for lacking express support in the specification, and also "new issue" for incorporating a new "process of use" element, which would require further consideration and/or search.
2. Applicants' argument that in Fig. 4 of JP '430 "the support tape 1 is flat when affixed onto an object 5 by pressing. In order for support tape 1 to be flat after being adhered to the object, the adhesive fastener must be brought into contact with the object by exuding through the voids of the intermediate material as discussed in this reference's abstract. In contrast to this reference, in the present invention, the adhesive layer is brought into contact with the article solely through deformation of the substrate." (Remarks, page 7, top paragraph) has been carefully considered, but is not persuasive. The Examiner repeats (see Paper No. 112603, page 3) that JP '430 expressly teaches an adhesive sheet (or fastener) which comprises a non-adhesive layer such as fine particles, fine fibers or fine mesh on an adhesive layer, and a support layer of paper, cloth, film, etc. (Abstract). As such, JP '430 clearly discloses the invention as claimed. The fact that in Fig. 4 JP '430 may also disclose an embodiment which comprises a rigid backing is irrelevant. It should be noted that a support layer such as paper, cloth, film clearly encompasses flexible sheet materials, which reads on the instantly claimed

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invention, and nowhere does JP '430 teaches that the support layer is limited to rigid materials. Further, in the absence of evidence to the contrary, it is the Examiner's position that the flexible JP '430 inherently forms an undulated configuration toward adherend under pressure.

3. With respected to Applicants' argument that "The adhesive fastener of JP '430 is sticky and presents difficulties in handling or use, such as sticking to the fingers and undesired areas of an article or machine." (Remarks, page 7, bottom paragraph), the Examiner repeats (see Paper No. 112603, page 3) that JP '430 expressly teaches that the adhesion and releasing of his invention can be repeated, because of the intermediate material (Abstract). As such, since JP '430 essentially teaches the same subject matter, and for the same application (repeated adhesion and releasing), it is the Examiner's position that a suitable adhesive is either inherently disclosed by JP '430, or an obvious optimization to one of ordinary skill in the art, Applicants' argument to the contrary notwithstanding. It should be noted that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01.

4. With respect to applicant's argument that Kurahashi reference "contains no disclosure that would motivate one of ordinary skill in the art to modify JP '430 in a manner that would enable the adhesive layer disclosed there to bond to an article according to the presently claimed mechanism ..." (Remarks, page 8, first full paragraph), the Examiner notes that JP '430 discloses the instantly claimed

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mechanism, as set forth above; further, Applicants clearly argues the references individually, in response to Applicant's arguments, it is asserted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

5. Finally, with respect to the Declaration filed 5/10/2004, the Examiner notes that Applicants' Remarks fail to present any argument why the Declaration would have rendered the instantly claimed invention unobvious over the prior references, nor does the Examiner find the Declaration is relevant to the patentability issues, as set forth above.

DANIEL ZIRKER
PRIMARY EXAMINER
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1700

Daniel Zinker